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09/777,902	02/07/2001	Hidehiro Matsumoto	040425/0149	4766

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EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/777,902

Applicant(s)

MATSUMOTO, HIDEHIRO

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-32 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-8, 11-22 and 25-32 and 35-39 have been examined. Application 09/777,902 (**INFORMATION COMMUNICATION SYSTEM, INFORMATION COMMUNICATION METHOD, AND INFORMATION PROVISION BUSINESS METHOD**) has a filing date 02/07/01 and a foreign priority 2000-031346 (02/09/2000).

### ***Response to Amendment***

2. In response of Office Action dated 05/18/04, the Applicant amended claims 1, 11-15, 25-29, 36, 38, cancel claims 9, 23, 33, 34 and added new claim 39.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-23, 25-35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (U.S. 6,029,195) in view of Uemura et al (6,430,161).

As per claim 1, Herz teaches:

An information communication system in which a service information provider registers in advance service information in information provision means, managed by a carrier, for providing the service information, and a user receives the service information

Art Unit: 3622

by accessing the information provision means via a communication network, comprising:

a database for separately storing profile information indicating attribute information of the user and preference information indicating a preference and taste of the user upon encrypting the profile information and preference information (see column 5, lines 5-67; column 40, lines 19-33; column 41, lines 14-21; column 44, lines 1-39);

*and storage means for, when the user accesses said information provision means, obtaining the profile information and preference information in accordance with contents of the access to said information provision means, and storing the profile information in said database (see column 5, lines 5-67; column 40, lines 19-33; column 41, lines 14-21; column 44, lines 1-39).*

Herz fails to teach:

wherein said storage means acquires and stores terminal attribute information of the user and communication attribute information required to access said information provision means as the profile information, *wherein the carrier comprises: means for providing first specific information to the user based on first profile information of the user that indicates a first type of terminal used by the user to access said information provision means, and based on first preference information that corresponds to data entries made by the user when accessing the first type of terminal; and means for providing second specific information to the user based on second profile information of the user that indicates a second type of terminal used by the user to access said information provision means; and based on second preference information that*

Art Unit: 3622

*corresponds to data entries made by the user when accessing the second type of terminal, wherein the first specific information is different from the second specific information.* However, Uemura teaches a system that acquires and stores users' terminals attributes information in users' profiles (see column 3, lines 37-65; column 4, lines 53-62; column 5, lines 46-53; column 7, lines 1-30; column 8, lines 29-55; column 9, lines 1-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would store terminal and communication attributes in the users' profiles, as taught by Uemura. This feature would help the Herz system to better target advertisements and information to users because Herz would dynamically collect information about the users' terminals from the users' profiles and would automatically select the amount and type of data that would be transmitted to the users (see Uemura column 9, lines 1-20). Therefore, Herz would adjust the advertisement displayed to the users based upon the type of terminal that the users are accessing to display the advertisement, as taught by Uemura. This feature would save time and money, as there is no purpose of transmitting information to users that would not be able to view it because their users' terminals would not be able to display the information.

As per claim 2, Herz and Uemura teach:

A system according to claim 1, wherein the profile information and preference information are pieces of information for which the user gave consent to disclosure (see column 5, lines 36-40).

As per claim 3, Herz and Uemura teach:

A system according to claim 1, further comprising means for generating a keyword for searching/ extracting information stored in said database on the service information provider side (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 4, Herz and Uemura teach:

A system according to claim 2, further comprising means for generating a keyword for searching/ extracting information stored in said database on the service information provider side (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 5, Herz and Uemura teach:

A system according to claim 3, further comprising information search means for searching said database to extract information in accordance with the keyword and supplying the extracted information to the service information provider (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 6, Herz and Uemura teach:

A system according to claim 4, further comprising information search means for searching said database to extract information in accordance with the keyword and supplying the extracted information to the service information provider (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 7, Herz and Uemura teach:

A system according to claim 5, wherein said information search means also supplies key information required to decrypt the extracted information (see column 93, lines 9-13).

As per claim 8, Herz and Uemura teach:

A system according to claim 6, wherein said information search means also supplies key information required to decrypt the extracted information (see column 93, lines 9-13).

As per claim 11, Herz and Uemura teach:

A system according to claim 1, wherein said storage means acquires and stores the preference information on the basis of link information obtained when the user sequentially selects menu items on a display screen in accessing said information provision means (see column 6, lines 16-43; column 8, lines 1-21).

As per claim 12, Herz and Uemura teach:

A system according to claim 1, wherein said storage means acquires and stores a filter condition as the preference information which is set when the user receives information from said information provision means and indicates necessity/non-necessity of information (see column 18, lines 10-30).

As per claim 13, Herz and Uemura teach:

A system according to claim 1, wherein said storage means acquires and stores positional information and a type of communication line, as the preference information, when the user is accessing (see column 94, lines 48-67; column 95, lines 56-60).

As per claim 14, Herz and Uemura teach:

A system according to claim 1, wherein said storage means acquires and stores as the preference information a use frequency of an access device through which the user is accessing (see column 57, lines 55-67).

Claim 15 contains the same limitation as claim 1 therefore the same rejection is applied.

Claim 16 contains the same limitation as claim 2 therefore the same rejection is applied.

Claim 17 contains the same limitation as claim 3 therefore the same rejection is applied.

Claim 18 contains the same limitation as claim 4 therefore the same rejection is applied.

Claim 19 contains the same limitation as claim 5 therefore the same rejection is applied.

Claim 20 contains the same limitation as claim 6 therefore the same rejection is applied.

Claim 21 contains the same limitation as claim 7 therefore the same rejection is applied.

Claim 22 contains the same limitation as claim 8 therefore the same rejection is applied.

Claim 25 contains the same limitation as claim 11 therefore the same rejection is applied.

Claim 26 contains the same limitation as claim 12 therefore the same rejection is applied.



Art Unit: 3622

Claim 27 contains the same limitation as claim 13 therefore the same rejection is applied.

Claim 28 contains the same limitation as claim 14 therefore the same rejection is applied.

As per claim 29, Herz teaches:

An information communication system in which a service information provider registers in advance service information in information provision means, managed by a carrier, for providing the service information provision means via a communication network, an information communication business method which uses a database in which profile information indicating attribute information of the user and preference information indicating a preference and taste of the user are stored after the profile information and preference information are encrypted and provides the stored information to the service information provider with a charge, comprising the steps of:

generating a keyword which is used by the service information provider to search the database (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24);

searching the database in accordance with the keyword, extracting information, and providing the extracted information to the service information provider (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24);

Herz fails to teach:

providing first specific information to the user based on first profile information of the user that indicates a first type of terminal used by the user to access said information provision means; and

providing second specific information to the user based on second profile information of the user that indicates a second type of terminal used by the user to access said information provision means;

wherein the first specific information is different from the second specific information *and wherein the first specific information consists of data entries made by the user when the user was using the first type of terminal and the second specific information consists of data entries made by the user when the user was using the second type of terminal (see Uemura column 5, lines 40-55).*

However, the same rejection applied to claim 1 is applied to claim 29.

As per claim 30, Herz and Uemura teach:

A system according to claim 29, wherein the profile information and preference information are pieces of information for which the user gave consent to disclosure (see column 5, lines 36-40).

As per claim 31, Herz and Uemura teach:

A system according to claim 29, further comprising providing key information for decrypting the extracted information when the extracted information is provided to the service information provider (see column 93, lines 9-13).

Claim 32 contains the same limitation as claim 31 therefore the same rejection is applied.

As per claim 35, Herz and Uemura teach:

A system according to claim 1, further comprising:

means for preferentially displaying first specific information to the user on a display when the user accesses the information provision means, the first specific information corresponding to previous selections made by the user when the user accessed the information provision means (see column 1, lines 16-42).

As per claim 37, A method according to claim 15 contains the same limitations as claim 35 therefore the same rejection is applied.

*As per claim 39, Herz and Uemura teach:*

*A system according to claim 29, wherein each of the data entries made by the user when the user was using the first type of terminal corresponds to additional preference information that is sent to the carrier so that the service information provider can provide specific information to the user in accordance with said each of the data entries (see Herz column 5, lines 20-67).*

Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (U.S. 6,029,195) in view of Uemura et al (6,430,161) and further in view of Crawford (U.S. 6,327,579).

As per claim 36, Herz fails to teach:

A system according to claim 33, wherein the first type of terminal is a telephone and the second type of terminal is a personal computer, and wherein the request for information by the user via the telephone automatically causes the information to be downloaded to the personal computer of the user, *and wherein the telephone is not a*

*component of the personal computer.* However, Crawford teaches in column 2, lines 12-17 that "these information providers automatically answer telephone calls placed by user's computers, automatically respond to information requests, and provide the information over the telephone line to the calling computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Herz system would receive users' telephone requests for obtaining information or data, as taught by Crawford, where the mobile terminal would not be part of a personal computer and previous to transmitting any data or information, Herz would determine the type of terminal that would receive the data, such as a personal computer and would dynamically adjust the amount and type of the data that would be transmitted to the users' terminals, as taught by Uemura. This feature would save time and money, as there is no purpose of transmitting information to users that would not be able to view it because their users' terminals would not be able to display the information. If the telephone terminal is a component or not of a personal computer would not patentably distinguished the claimed invention from the prior art, as the request for information would be performed the same in claim 37.

As per claim 38, A system according to claim 34 contains the same limitations as claim 36 therefore the same rejection is applied.

#### ***Response to Arguments***

4. Applicant's arguments filed 08/06/04 have been fully considered but they are not persuasive. The Applicant argues that Uemura does not teach that based on which type of terminal a user is currently using, the user is provided with specific information

Art Unit: 3622

directed to types of data requests made by the user when using that type of terminal. The Examiner answers that it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would store terminal and communication attributes in the users' profiles, as taught by Uemura. This feature would help the Herz system to better target advertisements and information to users because Herz would dynamically collect information about the users' terminals from the users' profiles and would automatically select the amount and type of data that would be transmitted to the users (see Uemura column 9, lines 1-20).

The Applicant argues that data entries made by the user when the user is using his/her personal computer are not utilized in determine a profile of the user when the user is using his/her portable telephone and vice versa. The Examiner answers that Uemura teaches that the user can input data to the system using a wireless and/or personal computers (see column 5, line 40 – column 6, line 15).

The Applicant argues that in Crawford is the same device of the user that makes the request and that receives the downloaded information and therefore Crawford does not read claims 36 and 38. The Examiner answers that it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Herz system would receive users' telephone requests for obtaining information or data, as taught by Crawford, where the mobile terminal would not be part of a personal computer and previous to transmitting any data or information, Herz would determine the type of terminal that would receive the data, such as a personal computer and would

Art Unit: 3622

dynamically adjust the amount and type of the data that would be transmitted to the users' terminals, as taught by Uemura.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
November 9, 2004

Yehdega R. H.